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Appln. No. ~~09/188,022~~  
Amdt. dated December 11, 2003  
Reply to Office Action dated September 16, 2003

### REMARKS

Applicant respectfully requests reconsideration and then allowance.

Applicant submits an amended Abstract. The Examiner's editorial suggestion is acknowledged. The amended Abstract does not limit the scope of the claimed inventions.

The edited claims reflect minor, trivial word changes without narrowing claim scope. Changing "Agglomerated" to "An agglomerated" in claim 1 has no affect on claim scope. Changing "Agglomerated" to "The agglomerated" has no affect on the claim scope of any amended dependent claim. So too with changing "dry mixes" to "a dry mix" or "the dry mix" etc. Double recitation of ranges has been obviated without narrowing claim scope. The new dependent claims are directed to each of the multiple ranges recited in the original claims. Inserting a "," (comma) before the transition in dependent claims has no affect on claim scope.

The new independent claim 20 is based on the original application, including the claims and Figures. Attention is directed to page 7, lines 4-6, page 9 last paragraph, and Figure 3.

#### Traversing the formality rejection

Applicant acknowledges the rejection under 35 U.S.C. §112(¶2).

First, Applicant respectfully requests the Examiner to reconsider and withdraw the first aspect of the rejection. The first aspect of the rejection is that "characterised in that" renders the claims indefinite. Whether or not claims 1-7 use "characterised in that" or "characterized in that" does not give rise to a rejection under 35 U.S.C. §112 (¶2). It is not seen where there is basis for interposing such a rejection. Indeed, the rejection itself is rather puzzling because as of September 29, 2003, there were 143,937 granted U.S. patents reciting "characterized in that" in one or more claims and there were 11,644 granted U.S. patents that recited "characterised in that" in one or more claims. *See, e.g.*, Exhibits A and B. Clearly, the transition phrases "characterized in that" or "characterised in that" are

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sufficiently definite that Examiners and PTO Quality Review allowed over 150,000 U.S. Patents to issue having a claim or claims with claim elements or claim limitations defined using the phrase in question.<sup>1</sup>

Consequently, it is respectfully submitted that changing "characterised in that" to "wherein" would simply be trading three words for one without narrowing any aspect of claim scope. Alternatively, if claim 1 were edited to delete the phrase "characterised in that" in its entirety, the resultant claim would be amended without narrowing any aspect of claim scope.

However, in this post-Festo world, one might be deemed remiss, even if the suggestion is ill-founded, for amending the transition phrase unless the Examiner first acknowledges in writing that such word change(s) would **not** narrow claim scope. If the Examiner persists in the rejection, Applicants respectfully suggest such acknowledgement could alleviate concerns.

Second, amending claims to eliminate a European-style recitation of broad and narrower ranges in a single claim, also does not narrow claim scope. The original but now amended claims retain the broader recited range, which does not narrow their claim scope. Each of the narrower ranges has been removed from the claims and added in a new dependent claim.

It is respectfully suggested that the Examiner reconsider and withdraw the formality rejection.

Applicant respectfully traverses the rejection under 35 USC 103(a) over Meister (U.S. Patent No. 6,217,931) in view of Dudacek (U.S. Patent No. 6,001,408).

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<sup>1</sup> The Examiner has pointed to no decision of either the Federal Circuit or the Board of Appeals in support of what appears to be a unusually strained mis-directed application of 35 U.S.C. §112(¶2).

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The Examiner "bears the initial burden, on review of the prior art . . . , of presenting a *prima facie* case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

An obviousness rejection cannot be predicated on the mere identification of individual components of claimed limitations in various items of prior art. There must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998); see also In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). That is, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification" Ex parte Metcalf, 67 USPQ2d 1633, 1635 (BOPI 2003), quoting in re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). "[I]t is incumbent upon the examiner to identify some suggestion to combine the references or make the modification." Ex parte Askman, Appeal No. 96-1548 (June 10, 1999) at page 5, quoting In re Mayne, 104 F.3d 1339, 1342 (Fed. Cir. 1997). The factual basis for an alleged suggestion "cannot be resolved on subjective belief and unknown authority." Ex parte Metcalf, 67 USPQ2d at 1635, quoting In re Lee, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

When an alleged prior art patent, including drawings, is silent on a quantitative relationship, rejections assuming the existence of any such quantitative relationship are undermined, and subject to being reversed. Hockerson-Halberstadt Inc. v. Avia Group International Inc., 58 USPQ2d (BNA) 1487, 1491 (Fed. Cir. 2000); Ex parte Brown, 19 USPQ2d (BNA) 1609, 1612 (BOPI 1990) ("since the prior art is silent as to this feature, we are unable to sustain the rejection ..."); Ex parte Isaksen 23 USPQ2d (BNA) 1001, 1006 (BOPI 2001), ("Forbes patent[s] are completely silent as to any sharpening effect and do not describe with any specificity what results ... magnetic treatment had on the razor blade edge," rejection reversed).

The problem addressed by the present method and the manner of its being addressed are neither disclosed nor would they have been suggested to a person of ordinary skill in the

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art by the reference. "A *prima facie* case of obviousness can be rebutted if the applicant ... can show 'that the art in any material respect taught away' from the claimed invention." In re Geisler, 116 F.3d 1465, 1469 (Fed. Cir. 1997) (quoting In re Malagri, 499 F.2d 1297, 1303 (CCPA 1974)). A reference teaches away when a person of ordinary skill, upon reading the reference, would have been led in a direction divergent from the path that was taken by Applicants.

Here, Applicant respectfully submits that there is no *prima facie* case of obviousness.

The present inventions would not have been obvious to a person of ordinary skill in the art in view of the references, even assuming that they would have been combined (a point not conceded). At page 5 the present specification discloses the present inventions instantly disperse and develop full viscosity-simultaneously in cold water containing liquids. Also, at page 6 the present specification explains Figure 3 shows the current inventions are *different* from the conventional pre-gelatinized starch products and have different characteristics, such as in developing full viscosity in cold milk.

The Meister document does not disclose or suggest an agglomerated starch and maltodextrin product that instantly disperses and develops full viscosity simultaneously in cold water containing liquids. Instead, at column 3 the references refers to pre-gelatinized starch mixed in a low bulk density maltodextrins matrix. This would appear to be or relate to a conventional pre-gelatinized type product.

At column 4, line 52 a person skilled in the art is taught to use certain non-aqueous processing aids, viz. they can be sprayed onto a blended mixture.

It would seem appropriate to consider the product according to the Meister document as one that does not satisfy the claimed invention. This would seem to be a reasonable conclusion in view of the comparison product in Applicant's Figure 3.

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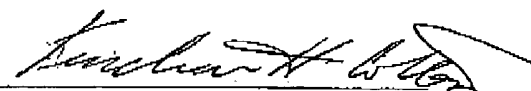
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The deficiency in the Meister document would not have been satisfied by the Dudacek document. The latter describes extrusions at column 2, line 26 of starch or mixtures of starch and gum, starch and surfactant, or starch, gum and surfactant. As indicated at column 3, lines 1-5, the extrudate is a heterogeneous mass of gelatinized, partially gelatinized and ungelatinized starch granules. This heterogeneous mass is also disclosed at column 7, lines 7-26. These passages do not appear to teach or disclose the agglomerates as claimed herein. At column 11, lines 56-63 the extruded starch and a maltodextrin are disclosed for "hot applications" and at column 11, line 64 et seq. only the extruded starch is cited for "cold applications." Also, even with agglomeration in Dudacek Example 5, a "specific ingredient addition sequence" is required and Example 5 refers to "fully pre-gelatinized starches" at column 14, line 41 or other gelatinized or heterogeneous product at column 14 bridging to column 15. Dudacek Example 5 also applies to hot media at column 15, line 15. At column 3, lines 46-48 the dissimilar agglomeration of Dudacek is related to dispersability in hot systems. It is therefore respectfully submitted that the secondary reference, even if combined with the primary reference, would not have led a person of only ordinary skill in the art to the claimed inventions.

Applicant therefore respectfully requests favorable reconsideration followed by a notice of allowance.

Respectfully submitted,

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